

54. (Previously presented) The system of claim 41, wherein the backup power supply is operatively coupled to a computer network and configured to transmit an electronic message to one or more designated computing devices that indicates the occurrence of the event when the audible alarm is disabled.

55. (Previously presented) The system of claim 41, wherein the backup power supply is operatively connected to a second computing device, the second computing device being configured to operate software installed thereon that is programmable to:

enable the audible alarm during at least a third predetermined time period in response to detection of the occurrence of the event, and

to disable the audible alarm while the backup power supply is operational during at least a fourth predetermined time period in response to detection of the occurrence of the event.

56. (Previously presented) The system of claim 41, wherein the backup power supply is an uninterruptible power supply.

Remarks

Applicants have carefully considered the Examiner's final Office Action and respond below. To further prosecution of the present application, claims 27 and 41 have been amended herein. Claims 27-56, therefore, are pending with claims 27 and 41 being in independent form. The claims are believed to be in allowable condition. Applicants respectfully request the reconsideration.

Rejection of Claims 27-56 Under 35 U.S.C. § 103(a)

Claims 27-56 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,958,054 to O'Connor ("O'Connor") in view of U.S. Patent No. 6,583,720 to Quigley ("Quigley"). Applicants respectfully traverse the rejection of claims 27-56 under 35 U.S.C. § 103(a) for the reasons given below.

The Examiner has rejected independent claim 27 under 35 U.S.C. § 103(a) as being unpatentable over O'Connor in view of Quigley because the combination of prior art references

teaches or suggests the method of claim 27. Specifically, the Examiner indicates that O'Connor discloses *programming the backup power supply through computer software operating on the computer to enable the audible alarm on the backup power supply during at least a first predetermined time period in response to detection of the occurrence of an event*. However, the Examiner fails to identify where O'Connor states such programming of a backup power supply to enable an audible alarm on the backup power supply during a first predetermined time period. In addition, the Examiner essentially admits that O'Connor does not disclose an audible alarm or *programming the backup power supply through the computer software to disable the audible alarm on the backup power supply while the backup power supply is operational during at least a second predetermined time period*, as recited in claim 27.

The Examiner states that O'Connor *does* disclose an I/O controller that will allow an operator to program when the alarm should operate and then makes the leap to state, essentially, that because the alarm is programmable, it would be obvious to program the backup power supply in the manner recited in claim 27. Applicants respectfully submit that just because O'Connor teaches a programmable controller that is capable of being programmed such a teaching *does not* mean it is obvious to program a backup power supply according to the programming method and with the specific functions that are recited in claim 27. *In re Gordon*, 221 U.S.P.Q. 1125 (Fed.Cir. 1984)(. . . [because] a prior art device could be modified so as to produce the claimed device is not a basis for an obviousness rejection unless the prior art suggested the desirability of such modification); and *In re Mills*, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990)(Although a prior art device 'may be capable of being modified to run the way [the patent applicant's] apparatus is claimed, there must be a suggestion or motivation in the reference to do so').

In particular, as the Examiner admits, O'Connor does not teach or suggest *programming the backup power supply through the computer software to disable the audible alarm on the backup power supply while the backup power supply is operational during at least a second (of two) predetermined time period*. Further, the Examiner does not cite any other prior art reference in addition to O'Connor that discloses or teaches the programming method and the specific functions recited in claim 27.

Therefore, the Examiner's conclusion indicates that the Examiner has relied upon Applicants' disclosure to modify O'Connor to recite the programming method and the specific

functions of claim 27. Such hindsight is impermissible and must be avoided to reach a proper determination of obviousness under 35 U.S.C. § 103. The conclusion of obviousness must be reached on the basis of the facts gleaned from the cited prior art and, in view of this factual information, a determination can then be made whether the claimed invention “as a whole” would have been obvious at the time the invention was made. (MPEP 2142).

Thus, the Examiner fails to identify either in O'Connor or any other prior art reference any disclosure or teaching that would motivate one of ordinary skill in the art to program through computer software running on a computer a backup power supply to enable and to disable an audible alarm on the backup power supply during at least a first and at least a second predetermined time period, as is recited in claim 27.

In addition, as a basis for the § 103(a) rejection, the Examiner further relies on the disclosure of a computer system 200 including an emulated UPS for providing a reliable power supply, and a portable computer system 500 receiving backup power via a serial port to a UPS emulation program. (col. 3, lines 36-60; col. 7, lines 53-67; col. 8, lines 40-51.) The Examiner also relies on the disclosure of a power management chip set 538 and a real time clock 540 connected to the chip set 538 and to an I/O controller 575 to transmit time events or alarms to the chip set 538. The real time clock 540 is typically programmed to generate an alarm signal at a predetermined time. (col. 7, lines 6-67; col. 8, lines 1-4).

Applicants respectfully submit such disclosure does not provide any teaching or suggestion of programming a backup power supply to enable and to disable an audible alarm on the backup power supply during at least a first and during at least a second predetermined time period. Rather, the disclosure the Examiner relies upon discloses a *programmable real time clock that generates an alarm at a predetermined time*. Such teaching of generating an alarm at a predetermined time is in contrast to *programming a backup power supply to enable and to disable an audible alarm during at least a first and at least a second predetermined time period*. In other words, O'Connor is not directed to enablement or disablement of an audible alarm of a backup power supply, nor to enablement or disablement of the real time clock, but is limited to programming the real time clock to issue an alarm at a predetermined time such as, for instance, at the expiration of a certain time after the detection of an event, such as a power loss. The real time clock of O'Connor according to the disclosure is thereby always enabled in order to generate an alarm at a predetermined time. This is different from the method of programming

the backup power supply to enable an audible alarm during at least a first predetermined time period and to disable the audible alarm during at least a second time period. For instance, the method of claim 27 permits an operator to program the backup power supply . . . to enable the audible alarm during at least a first predetermined time period, such as between 8:00 a.m. and 8:00 p.m. when an audible alarm is desired or required, and to disable the audible alarm when the backup power supply is operational during at least a second predetermined time period, such as between 8:00 p.m. and 8:00 a.m. when an audible alarm is not desired or required. The method of claim 27 thereby provides a method of enabling and disabling an audible alarm of a backup power supply during at least a first and at least a second predetermined time period in contrast to merely generating an alarm at a predetermined time.

The Examiner further relies upon Quigley as teaching or suggesting an audible alarm and a programmable timer. Specifically, the Examiner indicates that Quigley discloses a console 10 connected to sensing devices 24 that determines a predetermined time, set by a consumer, to activate an alarm in response to detection of a loss of electricity. Like O'Connor, Quigley discloses generating an alarm at a predetermined time in contrast to the method of claim 27 that recites a method of enabling and disabling an audible alarm of a backup power supply during at least a first and at least a second predetermined time period.

The Examiner indicates in conclusion that since O'Connor discloses a UPS device having an I/O controller and software program 700 to determine a time to generate an alarm it would have been obvious to incorporate such teaching with the audible alarm and the programmable timer of Quigley to set a schedule to alert a consumer of a loss of power to a computer, for instance, only during times when the consumer is near the computer. Applicants respectfully submit the cited combination of art does not teach setting a schedule as the Examiner suggests and, further, does not teach or suggest the method of claim 27. Mere disclosure of the I/O controller and UPS emulating program to determine a time to generate an alarm does not teach or suggest the method of programming a backup power supply to enable and to disable an audible alarm during at least a first and at least a second predetermined time period. In addition, Applicants respectfully submit that one of ordinary skill in the art would not be motivated by O'Connor to control an audible alarm of a backup power supply, or a programmable timer as disclosed in Quigley, by programming the backup power supply, or the programmable timer, to enable and to disable the audible alarm according to the method of claim 27. The Examiner has

essentially extended the teachings of O'Connor and Quigley beyond the scope of their respective disclosure to conclude that the cited combination of art renders the invention of claim 27 obvious.

Thus, Applicants respectfully submit that neither O'Connor or Quigley, alone or in combination, disclose controlling an audible alarm of a backup power supply through programming the backup power supply to enable and to disable the audible alarm during at least a first and at least a second predetermined time period, but only disclose generating an alarm at a predetermined time. Claim 27, therefore, is patentably distinguishable over O'Connor in view of Quigley. Accordingly, the rejection of claim 27 under 35 U.S.C. § 103(a) should be withdrawn.

Claims 28-40 depend from claim 27 and are patentable for at least the reasons given above.

Independent claim 41 has been similarly rejected under 35 U.S.C. § 103(a) as being unpatentable over O'Connor in view of Quigley. Applicants respectfully submit that for at least the same reasons discussed above with respect to patentability of claim 27, claim 41 is patentably distinguishable over O'Connor in view of Quigley. The rejection of claim 41 under 35 U.S.C. § 103(a), therefore, should be withdrawn.

Claims 42-54 depend from claim 41 and are patentable for at least the reasons given above with respect to claim 41.

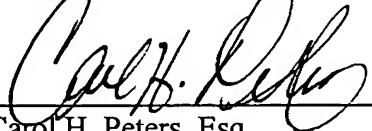
Request for Withdrawal of the Finality of the Examiner's Office Action
Due to Citation of Prior Art Not of Record

In the first Office Action mailed August 27, 2003, the Examiner identified U.S. Patent No. 5,958,054 to O'Connor as prior art of record not relied upon but considered pertinent to Applicants' disclosure. However, the Examiner did not identify U.S. Patent No. 6,583,720 to Quigley as prior art of record in the first Office Action, but has relied upon this reference to finally reject the claims under 35 U.S.C. § 103(a). Applicants respectfully submit that the Examiner's reliance upon Quigley, which the Examiner considers is pertinent to Applicants' disclosure and was not made of record, is new grounds for rejection of the claims. Therefore, the finality of the Office Action mailed April 6, 2004 is premature. TMEP § 706.07. In addition, Applicants respectfully submit that cancellation of claims 1-26 and addition of new claims 27-56 did not necessitate the application of the new reference and the new grounds for rejection of

claims 27-56. Claims 27-56 are directed to the same subject matter as claims 1-26 and vary merely with respect to scope. Applicants, therefore, respectfully request the Examiner vacate the finality of the rejection of claims 27-56.

Based upon the foregoing amendments and discussion, the present application is believed to be in condition for allowance, and an action to this effect is respectfully requested. Should the Examiner have any questions concerning this response, she is invited to telephone the undersigned.

Respectfully submitted,



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